

REMARKS

Claims 3-20 are now pending in the application. Applicants believe the claims as currently amended have been placed in a condition for allowance, and respectfully request the Examiner to reconsider and withdraw the rejection in view of the amendments.

REJECTION UNDER 35 U.S.C. § 112

Claims 6, 7, 9, 12, and 19 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Final Office Action states that the above claims contain subject matter which was not described in the specification, and points the Applicants attention to paragraph 112 of the current specification which states “three magnets in three mutually perpendicular planes”. The Final Office Action further states that there is lack of disclosure on how one skilled in the art could arrange these magnets in one plane. However, paragraph 141 of the specification clearly discloses and describes the subject matter of arranging magnets on a planar support, as required in the claims as amended.

Specifically, paragraph 141 of the specification discloses “a plurality (in this fourth embodiment four) of magnet coils 414 arranged on a planar support 416” and also “some or all of the coils may be oriented out of the plane of the planar support 416”. Figures 47-50 also clearly show a plurality of magnet coils on a planar support 416. Thus, the subject matter of “at least three coils” that are “arranged on a planar support” as required in the amended claims is consistent with the disclosure in the present application. As such, the above claims comply with the written description requirement.

REJECTION UNDER 35 U.S.C. § 103

Claims 3-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Werp (U.S. Pat. No. 6,015,414). This rejection is respectfully traversed.

The Final Office Action states that the apparatus in Werp et al includes six coils, the arrangement of which allows for four coils to be substantially in the same plane as given by the example: the x-y plane would include the +x, -x, +y, and -y coils. However, the example in the Final Office Action does not disclose a plurality of magnetic coils arranged on the plane of a planar support. While Werp et al shows six magnetic coils for providing a magnetic field in an operating region effective for navigating a medical device, Werp does not suggest how to arrange a plurality of coils on one plane of a planar support. Rather, Werp et al discloses six coils arranged in three mutually perpendicular planes, which require significant support structure and occupies a considerable space around the patient. As shown in Fig. 47, the arrangement of magnets on planar support 416 provides more space around the patient, and allows for positioning a patient in an opening 422 of a compact CT imaging device that is not significantly affected by the proximity of the magnets (paragraph 142). Werp et al. does not provide the motivating force that would suggest how one skilled in the art could arrange a plurality of magnetic coils on a plane of a planar support as applicants have done, to accommodate an imaging device having an opening 422 through which a patient can extend “to allow the surgeon to bring virtually any portion of the patient within the operating region of magnet assembly 404 (paragraph 142). Obviousness cannot be established without also providing evidence of the motivating force which would impel one skilled in the art to do what the applicants have done. *MPEP 2144.*

Applicants have cancelled claim 20 without prejudice.

NEW CLAIMS

Applicants have added claims 21 and 22 depending from independent claim 19, which applicants believe to be allowable in view of the above remarks. As such, Applicant submits that claims 21 and 22 are also allowable for at least these reasons.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, and that the claims are in a condition for allowance. Applicant therefore respectfully requests that the Examiner allow the application, or at least withdraw the finality of the outstanding rejections made in the Final Office Action. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 726-7500.

Respectfully submitted,

Dated: 1 MARCH 2005

By: 
Bryan K. Wheelock, Reg. No. 31, 441

HARNESS, DICKEY & PIERCE, P.L.C.
7700 Bonhomme, Suite 400
St. Louis, Missouri 63105
(314) 726-7500

[BKW/kmp]